

REMARKS

Claims 1-20 and 22-35 are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Claim Status

Claims 1-2, 5-7, 15-17, 22-28, 30, and 32-34 were rejected under 35 U.S.C. § 103(a) over Watari (US 2001/0003345) in view of Sawada (US 5,835,816).

Claims 3 and 18-19 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Motomura (US 4,521,102).

Claim 4 was rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Howard (US 2002/0126849).

Claims 8-14 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Graef (US 2002/0036159).

Claim 20 was rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada, Motomura, and Howard.

Claims 29 and 31 were rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Brannan (US 5,850,075).

Claim 35 was rejected under 35 U.S.C. § 103(a) over Watari in view of Sawada and Fukuda (JP 2003/157,465).

The amendment

The Applicant respectfully traverses the rejections. Nevertheless, claims have been amended as a courtesy to the Office to advance prosecution toward allowance.

Applicant traverses the 35 U.S.C. § 103(a) rejections

The Action relies on Watari for teaching an automated banking machine that can provide receipts. The Action admits that Watari does not teach or suggest the recited steps. Sawada is directed to prediction of future critical errors in paper copier machines (e.g., col. 2, lines 1-2 and 16-23) to enable a serviceman to service the machine before the predicted critical error actually occurs. Motomura is directed to counting paper sheets in a paper copier machine. That is, both Sawada and Motomura are directed to duplicating (copying) machines. One skilled in the automated banking machine art would have recognized that *reproducing* a paper sheet with a paper copier machine does not relate to *originally* printing a transaction receipt with an automated banking machine, and even more so if the paper sheet is sized (e.g., 8.5 x 11) differently than the transaction receipt. Neither Sawada nor Motomura is related to banking transactions, transaction receipts, receipt jams, or transaction receipt jams in an automated banking machine. Thus, one skilled in the art of automated banking machines would have recognized that both Sawada and Motomura are non analogous art.

As previously discussed, Sawada is *not* directed to transaction receipts. Nor does Sawada even teach or suggest sending a second paper sheet in the same paper sheet path while a determined-jammed first paper sheet remains jammed. Rather, Sawada conventionally teaches that an operator of a copier machine removes a jammed sheet (e.g., col. 5, lines 53-58) before another sheet is sent (else the same jam would be inaccurately continuously detected and counted).

The Action (e.g., at page 19) alleges that Motomura teaches "while the first receipt remains in the jammed condition in the machine, sending a second receipt in the receipt path toward the receipt outlet". The Applicant respectfully disagrees. As previously discussed,

Motomura is *not* directed to transaction receipts. Nor does Motomura even teach or suggest that after a first paper sheet is determined to be jammed in a copier machine, a second paper sheet is sent in the same paper sheet path while the first paper sheet still remains jammed. The section (col. 5, lines 18-20) of Motomura relied upon in the rejections reads as follows:

"If two copy papers are sequentially jammed in the transporting direction of the copy paper transport path, the value of the subtracting counter of feeding 17 becomes equal to the value of the number of the occasion of the paper jamming plus 2. Similarly, the value of the number of the occasion of the paper jamming plus 2 is displayed at the display station 2".

Upon reading Motomura as a whole, one would understand that the relied upon section refers to adjusting the number of Motomura's feed counter (17) due to the number of jammed sheets removed. In the example provided in the relied upon section, the feed counter number is adjusted by two. The relied upon section has nothing to do with sending a second paper sheet *while* the determined-jammed first paper sheet still remains jammed. Conversely, Motomura teaches that jammed paper is always manually removed before copying is restarted or continued (e.g., col. 1, lines 27-29; col. 2, lines 8-9 and 19-20; col. 3, lines 53-55; col. 6, lines 36-39). That is, Motomura (like Sawada) conventionally teaches that an operator of a copier machine removes a jammed sheet before another sheet is sent. As the rejections are based on the Office's misinterpretation of Motomura, they are not legally valid.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one skilled in the art to have combined the references in the manner proposed by the Office to have produced the recited invention. Even if it were somehow possible (which it isn't) to have combined the references as proposed, the result still would not have produced the recited invention. The record is absent a teaching, suggestion, motivation, or valid reason for one of

ordinary skill in the art to have produced the recited invention. The rejections are based solely on attempted hindsight reconstruction of the claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness.

The dependent claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been shown to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis. Furthermore, each of the dependent claims recites additional specific features and relationships that further patentably distinguish the claimed invention over the applied art.

The rejections are legally improper

The rejections are based on features improperly attributed to references

The 35 U.S.C. § 103(a) rejections are further faulty because, in contrast to an understanding of the references by a person having ordinary skill in the art at the time of the present invention, they are based on (the Office) improperly attributing features to the references which are neither taught nor suggested thereby.

The applicable legal standard for "obviousness" has not been met by the Office

Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections are legally improper because the required legal criteria for establishing "obviousness" has not been met by the Office. In order to present a valid rejection based on obviousness, it is first necessary for the Office to make a *prima facie* showing of obviousness. *Prima facie* obviousness requires a showing that each of the recited features and relationships in the claims was known in the prior art. If the Office fails to establish a *prima facie* case of obviousness (which is the current situation), then Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Even in cases where the Office has established a *prima facie* showing of obviousness, a rejection cannot be properly made unless there is a requisite showing that it would have been obvious to one having ordinary skill in the art at the time the invention was made, to have combined features and relationships to have produced (at that time) the invention as claimed. In accordance with the dictates of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the determination as to whether there is a reason to combine prior art features must be evaluated through an analysis of the factors recited in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The factual inquiries that must be made under *Graham* include:

- (a) determining the scope and content of the prior art,
- (b) ascertaining the differences between the prior art and the claims in issue,
- (c) resolving the level of ordinary skill in the pertinent art, and
- (d) evaluating evidence of secondary consideration.

The Action fails to present a proper *Graham* analysis

In accordance with the requirements of *Graham*, it is mandatory that before a claim can be rejected on the basis of obviousness, the Office is required to make a factual determination and resolve the level of ordinary skill in the pertinent art which existed at the time Applicants' invention was made. MPEP § 2141(2)(C). It is respectfully submitted that the Action does not include such a full determination. That is, there is no evidence of record that the level of one of ordinary skill in the art at the time of Applicants' invention has been resolved by the Office. Nor has the record established the Examiner to be a person of ordinary skill in the art at the time of Applicants' invention.

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The rejections are not based on one of ordinary skill in the art at the time of the present invention

The 35 U.S.C. § 103(a) rejections are also faulty because they do not correctly apply the level of ordinary skill in the art at the *time of the present invention*. Rather, the Office continues to improperly attempt to apply a “2008” level of ordinary skill in the art.

The record shows that the reasons for combining features of the references in the rejections are based on the mere opinion of the Examiner. Thus, it must be concluded that the basis for combining features of the cited references in the rejection is *not* based on the opinion of a person of ordinary skill in the art at the time of the present invention. That is, the alleged reasons for combining features of the cited references are at best based on the opinion of the Examiner, which opinion is entitled no evidentiary weight because (as previously discussed) the Examiner has *not* been established in the record as a person of ordinary skill in the art at the time of the present invention. For this additional reason, Applicants respectfully submit that the rejections are legally improper and should be withdrawn.

Conclusion

Applicant respectfully submits that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office’s convenience.

Respectfully submitted,

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